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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,682	10/29/2003	Xing Su	21058/1206739-US1	9817

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EXAMINER

HA, JULIE

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

08/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/697,682	Applicant(s) SU ET AL.	
	Examiner JULIE HA	Art Unit 1654	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-8 and 10-16.
- Claim(s) withdrawn from consideration: 17-30.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see continuation 11 below.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/J. H./
Examiner, Art Unit 1654

/Anish Gupta/
Primary Examiner, Art Unit 1654

Continuation of 11. Objection to claim 31 as being substantial duplicate is hereby withdrawn due to Applicant's cancellation of claim 31.

Claim 2 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 2 recites the limitation "template nucleic acid into each chamber" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. The template nucleic acid is never mentioned in claim 1. The first time template nucleic acid appears is in claim 2.

Applicant argues that "claim 2 introduced the template nucleic acid with the transition phrase "further comprising". As such, there is simply no need for antecedent basis in claim 1."

Applicant's arguments have been fully considered but have not been found persuasive as set forth in the previous office action. Briefly, claim 1 is drawn to labeled proteins, polypeptides or peptides, not to template nucleic acid. The labeled proteins, polypeptides or peptides already exist in claim 1. Claim 2 is dependent on claim 1, requiring the steps of claim 1. Further, it is unclear if only peptides are required to obtain labeled proteins, polypeptides or peptides as in claim 1, or nucleic acid encoding the proteins, polypeptides or peptides are also required, as in claim 2. Therefore, it is unclear how obtaining a plurality of labeled proteins, polypeptides or peptides occurs prior to claim 2.

Claims 1, 4-5, 7-8, 10-14 and 16 remain rejected under 35 U.S.C. 102(b) as being anticipated by Chan EY (US Patent No. 6,210,896); Claims 1, 4-5, 7-8, 10-14 and 16 remain rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Chan EY (US Patent No. 6,355,420).

Applicant argues that "Chan '896 merely teaches that more than one polymer can be analyzed at a time if multiple signal stations are provided. At best, Chan is silent as to the use of "plurality of chambers, such that different chambers contain a different type of labeled amino acid," as recited in independent claim 1." Further, Applicant argues that "Chan '420 merely teaches the unremarkable fact that different detectors will detect different labels. Chan '420 does not teach a method of using a "plurality of chambers, such that different chambers contain a different type of labeled amino acids," as recited in independent claim 1."

Applicant's arguments have been fully considered but have not been found persuasive, as set forth in the previous office action. Briefly, Chan reference as a whole teaches the claimed invention of instant application. Chan reference teaches methods and products for analyzing polymers. Chan reference teaches that each type of amino acid is labeled with a different light emissive compound having a distinct light emissive pattern then each amino acid will interact with the agent to produce a distinct signal. ...and multiple polymers can be analyzed simultaneously. Specifically, Chan reference teaches that the FRET analysis can be performed on a single molecule in solution or as parallel reactions on a solid planar medium, or in different solutions, such as multi-well dishes (see column 9, lines 29-32). Since each amino acid is labeled differently with different compound, and can be in a different solution, such as multi-well dishes, the reference anticipates the instant claims.

Claim 3 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Chan EY (US Patent No. 6,210,896) as applied to claims 1, 4-5, 7-8, 10-14 and 16 above.

Applicant argues that neither Chan '896 nor Chan '420 teach or suggest "a plurality of chambers, such that different chambers contain a different type of labeled amino acid," as recited in independent claim 1."

Applicant's arguments have been fully considered but have not been found persuasive, as set forth in the previous office action, and as stated above.

Claims 2, 6 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Chan EY (US Patent No. 6,210,896) as applied to claims 1, 4-5, 7-8, 10-14 and 16 above, in view of Thompson et al (US Patent No. 5,324,637).

Applicant argues that neither Chan '896 nor Chan '420 teach or suggest "a plurality of chambers, such that different chambers contain a different type of labeled amino acid," as recited in independent claim 1." Applicant further argues that "Thompson merely teaches, "a simple method for producing protein from a template DNA in a standard in vitro translation reaction utilizing a eukaryotic cellular lysate. Thompson does not teach or suggest "a plurality of chambers, such that different chambers contain a different type of labeled amino acid," as recited in independent claim 1."

Applicant's arguments have been fully considered but have not been found persuasive, as set forth in the previous office action, and as describe above. Chan reference teaches that each type of amino acid is labeled with a different light emissive compound having a distinct light emissive pattern then each amino acid will interact with the agent to produce a distinct signal. ...and multiple polymers can be analyzed simultaneously. Specifically, Chan reference teaches that the FRET analysis can be performed on a single molecule in solution or as parallel reactions on a solid planar medium, or in different solutions, such as multi-well dishes. Thompson reference teaches that another method of measuring the amount of protein produced in coupled in vitro transcription and translation reactions is to perform the reactions using a known quantity of radiolabeled amino acid such as S35-methionine or H3-Leucine. As described in the KSR analysis, sequencing polymer methods are slow and labor intensive, each process taking about 1-3 days. Therefore, performing a transcription coupled translation and radiolabeling the protein that is translated from RNA is "the product not of innovation but of ordinary skill and common sense," leading to the conclusion that invention is not patentable as it would have been obvious.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier

communications from the examiner should be directed to JULIE HA

whose telephone number is (571)272-5982. The examiner can normally be reached on Mon-Thurs, 5:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.